

Attorney Docket No.: J2071(C)
Serial No.: 10/559,115
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BRIEF FOR APPELLANT

Sir:

This is a Brief on Appellants' Appeal from the Examiner's Final Rejection concerning the above-identified application.

The Commissioner is hereby authorized to charge any additional fees, which may be required to our Deposit Account No. 12-1155, including all required fees under: 37 C.F.R §1.16; 37 C.F.R. §1.17; 37 C.F.R. §1.18; 37 C.F.R. §1.136.

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I. REAL PARTY IN INTEREST

The Real Party in Interest in this Appeal is Conopco, Inc., d/b/a UNILEVER, a corporation of the State of New York.

II. RELATED APPEALS AND INTERFERENCES

Neither the Appellants, their legal representatives nor the Assignee are aware of any other Appeals or Interferences relating to the present Appeal.

III. STATUS OF CLAIMS

This Appeal is taken from the Final Rejection of claims 1 through 9, the pending claims in the application. A copy of the appealed claims is attached to this Brief as an Appendix.

IV. STATUS OF AMENDMENTS

A Reply under 37 CFR § 1.116 in response to the Final Rejection was filed on January 8, 2010. The Reply was entered and considered by the Examiner for purposes of this Appeal.

V. SUMMARY OF THE CLAIMED SUBJECT MATTER

The invention set forth in the claims on appeal is directed to a cosmetic skin lightening composition comprising extracts of plants from the genera *Symplocos* and *Rubia*, the extract of *Symplocos* being selected from *Symplocos recemosa*, *Symplocos paniculata*, *Symplocos cochinchinensis* or mixtures thereof; the extract *Rubia* being *Rubia cordifolia*. Such extracts within the skin lightening composition are the primary skin lightening agents supplied to benefit the consumer.

By the presently claimed invention, therefore, a superior cosmetic skin lightening composition has been invented. As may be readily gleaned from the Examples, surprisingly synergistic lightening benefits are obtained when the claimed invention is used.

In the Specification, the portion from page 1 to page 4, line 14 comprises background. The phraseology used in claim 1, the sole independent claim, may be found, for example, on page 5 of the specification as originally filed. Support for dependent claim 2 is found, among other places, on page 7, line 2 and support for claim 3 may be found, among other places, on page 6, line 11 of the specification. Support for claims 4 and 5 may be found, among other places, on pages 5 and 7 (respectively) of the specification. Claims 6 through 9 are supported by the specification at pages 5 and 6. All claims, therefore, are supported by the specification as originally filed. Beginning at page 9, working examples illustrate the unexpected and superior properties obtained when making the compositions of this invention.

VI. GROUNDS OF THE REJECTION TO BE REVIEWED ON APPEAL

The issue raised in this appeal is primarily one of fact and of the type normally encountered in connection with a rejection made under 35 USC § 103. In particular, the issue is as follows:

Would one of ordinary skill in the art, upon reading Osumi et al., Japanese Publication (JP 20033055184) in view of Deckner et al. (US 5,968,528) prepare a skin lightening composition as claimed in the present invention?

VII. ARGUMENT

Rejection Under 35 USC § 103

The Examiner continues to reject claims 1-9 under 35 USC § 103 as being unpatentable over Patent Abstracts of Japan, Publication No. JP 2003-055184 (hereinafter, '184) in view of Deckner et al., U.S. Patent No. 5,968,528 (hereinafter, '528). The Examiner mentions that the rejection is maintained for the reasons of record. The Examiner further notes, in summary, that the '184 reference teaches a skin care composition with bleaching action wherein the composition has an extract from the plant *Symplocos recemosa*. The Examiner maintains that the extract may be extracted from bark or other parts of a plant and that extracts from *Symplocos* can have excellent oxygen scavenging activity as well as collagenase and tyrosinase inhibitory actions. The Examiner continues and maintains that the '184 reference describes a skin care composition that yields excellent aging prevention actions.

Inherently, the Examiner notes that the '184 reference does not, even remotely, describe the use of Vitamin B3 and extracts from the plants of the

genus *Rubia*, particularly *Rubia cordifolia*. Nevertheless, the Examiner relies on the '528 reference for curing the deficiencies of the primary reference, and mentions that the same describes compositions with Vitamin B3 and extracts from plants of genus *Rubia*.

In view of the above, the Examiner, again, believes that it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the instantly claimed ingredients mentioned in the references since the Examiner believes the idea for combining the same flows logically. Thus, the Examiner, again, continues to believe that the rejection made under 35 USC §103 is warranted.

Notwithstanding the Examiner's apparent position to the contrary, it is the Appellants' position that the presently claimed invention is patentably distinguishable from the above-described for at least the following reasons.

As already made of record, the present invention, as presented in independent claim 1, is directed to a cosmetic skin lightening composition comprising 0.1 to 50% by wt. of extracts of plants from the genera *Symplocos* and *Rubia*, the extract of *Symplocos* being selected from *Symplocos recemosa*, *Symplocos paniculata*, *Symplocos cochinchinensis* or mixtures thereof and the extract of *Rubia* being *Rubia cordifolia* wherein the extracts are primary skin lightening agents within the composition.

The invention of claim 1 is further defined by the dependent claims, which claim, among other things, that sunscreen may be employed and the amount of sunscreen, that secondary skin lightening agents may be employed, specific

extract that may be employed, the type of sunscreen that may be employed, the type of secondary skin lightening agent that may be employed, and the additional types of extracts that may be used. Claim 9 further characterizes the composition of claim 1 in that the secondary skin lightening agent that may be employed is niacin, niacinamide, or niacinamide ascorbate.

In contrast, and as already made of record, the '184 reference merely discloses that an extract from the plant of the genus *Symplocos* may be used in a skin care preparation that exhibits anti-aging benefits and bleaching actions. The reference fails in every way to specifically describe all of the specific *Symplocos* extracts set forth in the claimed invention. Moreover, the reference is deficient in that it fails in every way to describe the extract of *Rubia* used in conjunction with *Symplocos* extract.

In an attempt to cure the vast deficiencies of the primary reference, namely the '184 reference, the Examiner, again, relies on the '528 reference which merely mentions that extract in the genus *Rubia*, particularly *Rubia cordifolia*, can be used as a natural anti-inflammatory agent. There is no teaching whatsoever in the '528 reference that even remotely suggests an extract of *Rubia* will yield excellent skin lightening benefits when used in conjunction with extract of *Symplocos*. There is also no teaching whatsoever that even remotely suggests that such extracts in combination will yield a stable composition. Moreover, there is no teaching whatsoever in the references relied on by the Examiner that even remotely suggest the unexpected synergistic benefits the inventors observed when using a mixture of the aforementioned extracts. Appellants, again, wish to direct the Examiner's attention to, for example, Table 1 of the specification as originally filed wherein it

is shown that a combination of *Rubia* and *Symplocos* extracts show a synergistic reduction in the amount of melanin formed in a culture of melanocytes which would result in skin lightening. Appellants wish to particularly point out to the Examiner that the data in Table 1 shows *Rubia* alone had no influence on the amount of melanin formed. The results in this invention would not, therefore, have been predictable to the skilled artisan. Moreover, the data in Table 2 of the specification clearly shows that *Rubia* and *Symplocos* extracts alone and in combination with one another decrease the uptake of melanin by keratinocytes as proven via testing with HaCaT keratinocytes in culture.

In view of the above, Appellants respectfully submit that a *prima facie* case of obviousness has not been established and that all claims of record are in condition for allowance.

Turning to the Examiner's response to the arguments made under 37 CFR §1.111, the Examiner mentions that the fact that Appellants recognize another advantage which would flow naturally from the art is not a basis for patentability. Further, the Examiner dismisses any claim to unexpected results/synergy since the Examiner believes it is unclear if the claimed range is for one or both extracts.

Notwithstanding the above, Appellants respectfully disagree. Firstly, the Examiner has not previously raised any issues regarding the range of "0.1-50%" being indefinite. The assertion cannot be made now, and the claim covers a composition with 0.1 to 50% by weight total extract.

It is well settled that an obviousness rejection cannot be sustained via a mere conclusory statement. The results the present inventors obtained and consistent with the claimed invention are not predictable and not the result of a simple substitution. There is no reason provided by the Examiner as to why the extracts in the disclosures should be combined when one extract is relied on for whitening enhancement and extracts from genus *Rubia* are taught for use as an anti-inflammatory agent. Furthermore, Appellants, again, have shown that *Rubia* alone did not influence the amount of melanin formed. In the present case, therefore, the person of ordinary skill in the art would not have reasonably looked to the secondary ('528 reference) to enhance lightening with an extract of *Rubia*. Finally, Appellants unexpected/synergistic results cannot be ignored and this invention would not have been predicted at the time of making.

Reconsideration and favorable action are earnestly solicited.

VIII. CONCLUSION

Appellants respectfully request that the Board of Patent Appeals and Interferences reverse the Examiner's final rejection of claims 1-9 under 35 U.S.C. §103.

Respectfully submitted,

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IX. CLAIMS APPENDIX

1. A cosmetic skin lightening composition, comprising 0.1 – 50% by weight of extracts of plants from the genera *Symplocos* and *Rubia*; the extract of *Symplocos* being selected from *Symplocos recemosa*, *Symplocos paniculata*, *Symplocos cochinchinensis* or mixtures thereof; the extract of *Rubia* being *Rubia cordifolia*

wherein the extracts are primary skin lightening agents within the composition.

2. The cosmetic skin lightening composition of claim 1, additionally comprising 0.1 – 10% by weight of a sunscreen.
3. The cosmetic skin lightening composition of claim 1, further comprising 0.1 – 10% by weight of one or more secondary skin lightening agents.
4. The cosmetic skin lightening composition of claim 1, wherein the extract of *Symplocos* is *Symplocos recemosa*.
5. The cosmetic skin lightening composition of claim 2, wherein the sunscreen is selected from 4-tertiary butyl-4'-methoxy dibenzoylmethane, 2-ethyl hexyl methoxy cinnamate, micronized titanium dioxide, or micronized zinc oxide.
6. The cosmetic skin lightening composition of claim 3, wherein the secondary skin whitening agent is niacin, niacinamide, niacinamide ascorbate, extract of placenta, hydroquinone, kojic acid, azelaic acid, sebacic acid, ascorbic acid, lactic acid, glycolic acid, malic acid, tartaric acid, ferulic acid or retinol.

7. The cosmetic skin lightening composition of claim 1 further comprising extracts of *Glycyrrhiza*, *Coriandum*, *Acorus* or mixtures thereof.
8. The cosmetic skin lightening composition of claim 1 wherein the *Symplocos* or *Rubia* is extracted from the bark of the plant.
9. The cosmetic skin lightening composition of claim 3 wherein the secondary skin lightening agent is niacin, niacinamide or niacinamide ascorbate.

X. EVIDENCE APPENDIX

No evidence, pursuant to §§ 1.130, 1.131 and/or 1.132, is submitted herewith.

XI. RELATED PROCEEDINGS APPENDIX

No decisions rendered by a Court or the Board have been made; therefore, no such decisions are submitted herewith.